



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

05

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
097034.415	03/04/98	MICHAUD	1798-7267

IM61/0130

FREDERICK F. CALVETTI
C/O SMITH, GAMBRELL & RUSSELL
1850 M. STREET, N.W.
SUITE 800
WASHINGTON DC 20036

EXAMINER

CROSS.L

ART UNIT	PAPER NUMBER
----------	--------------

1743

DATE MAILED: 01/30/01

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/034,415

Applicant(s)

Michaud

Examiner

LaToya Cross

Group Art Unit

1743



☒ Responsive to communication(s) filed on Dec 6, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-15 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-15 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1743

DETAILED ACTION

Continued Prosecution Application

1. The request filed on December 6, 2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/034,415 is acceptable and a CPA has been established. Claims 1-15 are pending in the instant application. An action on the CPA follows.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

OK 3. Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants have incorporated the phrase "and has physical characteristics similar to those of CFC 113 and HCFC 141b", into independent claim 1. Applicants state that support for this limitation may be found at page 2 of the instant specification. It is submitted that neither page 2, nor any other portion of the specification provide support for

Art Unit: 1743

this limitation. Page 2 of the specification describes other compounds which possess physical characteristics similar to CFC 113 and HCFC 141b. The physical characteristics of Applicants' composition are not provided and there is no statement that would lead one to believe that the claimed composition has characteristics similar to those of CFC 113 and HCFC 141b. The new matter must be canceled.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites a formula for the polyfluorinated alcohol compound. It appears that an -OH group is missing from the formula.

OK
Claim 1 also recites that the composition has physical characteristics similar to those of CFC 113 and HCFC 141b. The term "similar" is unclear. How alike must the physical properties of the claimed composition be in order to be "similar" to the compounds CFC 113 and HCFC 141b?

OK
Also, in claim 1 it is unclear as to how it is possible for a composition to have physical properties similar to a compound. Further clarification is required.

Art Unit: 1743

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6 and 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 3,957,672 to Zisman et al (hereinafter Zisman et al '672).

Applicants' claimed invention is directed to a dewetting composition consisting essentially of at least one surfactant in admixture with at least one fluorinated solvent and at least one water immiscible polyfluorinated alcohol having a specified formula.

Zisman et al '672 disclose a surface active composition for displacing aqueous or organic liquid films from solid surfaces. The surface active composition contains a fluorinated polyether which provides the surface activity to the composition. The composition may additionally contain fluoroalcohols and perfluoroalkane solvents. See claim 1 of Zisman et al '672. The fluoroalcohols have the formula $F(CF_2)_mCH_2OH$, similar to that instantly claimed by Applicants and encompassing Applicants' preferred alcohol, tridecafluorooctanol. The fluoroalcohols are present in an amount of up to 1% (col. 3, lines 10-34 and col. 7, lines 30-33). The perfluoroalkane solvents may include perfluorohexane and are present in an amount of up to 99% by volume.

Art Unit: 1743

Zisman et al '672 differ from the instantly claimed invention in that there is no disclosure of the composition not exhibiting a flash point. However, because the composition of Zisman et al '672 comprises similar components as claimed by Applicants, one of ordinary skill in the art would expect that they would have similar properties including flash point, absent evidence to the contrary.

Also Zisman et al '672 do not disclose the boiling point of the fluorinated solvents. However, since the reference discloses perfluoroalkane solvents (i.e. perfluorohexane), which are the same as Applicants' claimed solvents, one would expect that the boiling point would fall within the claimed range.

Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be obvious within the meaning of 35 USC 103 in view of the teachings of Zisman et al '672.

8. Claims 1-3 and 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zisman et al '672 in view of US Patent 5,514,301 to Bil et al (hereinafter Bil et al '301).

A different embodiment of Zisman et al '301 consists of the displacement of liquids from solid surfaces for short periods of time. In this embodiment, Zisman et al '672 disclose the use of the fluorinated polyether compound as a solvent in combination with the fluoroalcohol (col. 4, lines 56-65).

This embodiment differs from the instantly claimed invention in that no surface active agent is provided.

Art Unit: 1743

Bil et al '301 teach compositions for dewetting solid surfaces. The compositions of Bil et al '301 comprise a surface active material prepared by the reaction of alkyl phosphoric acids, fluorinated amine and a quaternary ammonium chloride in solution with a halogenated solvent. Bil et al '301 disclose that in using such surface active agents, the deemulsification time can be reduced and in the dewetting process, separation of the aqueous phase and organic phase will be accelerated. See col. 1, lines 26-32 and col. 2, lines 1-8.

Thus, it would have been obvious to one of ordinary skill in the art to use the surface active agent described in Bil et al '301 in the dewetting compositions of Zisman et al '672 in order to allow the emulsion formed by the dewetting composition with the extracted water to better separate into two phases allowing the aqueous phase to be removed faster.

Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be obvious within the meaning of 35 USC 103 in view of the teachings of Zisman et al '672 and Bil et al '301.

Response to Arguments

9. Applicant's arguments filed on December 6, 2000 have been fully considered but they are not persuasive.

With respect to the Zisman et al '672 reference, Applicants argue that the reference discloses a fluorinated polyether compound which Applicants exclude by using the phrase


Art Unit: 1743


"consisting essentially of". In response, Zisman et al '672 teach that the fluorinated polyether provides surface activity (col. 1, lines 48-52) and may also serve as a solvent for the fluoroalcohol (col. 4, lines 56-65). Thus, Applicants have not excluded the fluorinated polyether of Zisman et al '672 since the polyether may serve as a surfactant or a fluorinated solvent.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is (703) 305-7360. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden, can be reached at (703) 308-4037. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

LIC 
January 20, 2001


Jill Warden
Supervisory Patent Examiner
Technology Center 1700